

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEROME M. WITT,
BENJAMIN R. GROESER,
and MORSE L. ROBERTS

Appeal No. 1998-1431
Application No. 08/665,162¹

ON BRIEF

Before CALVERT, MEISTER, and CRAWFORD, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 6, 7, 10, 11, 13, 15, 16, 19 and 20, which are all of the claims pending in this application. Claims 2, 4, 5, 8, 9, 12, 14, 17 and 18 have been canceled.

¹ Application for patent filed June 14, 1996.

Appeal No. 1998-1431

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The appellants' invention relates to a bag which has a sidewall having a support attached thereto. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The references

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Rosenbloom, Jr. et al. 1981 (Rosenbloom)	4,290,468	Sep. 22,
McBride 1995	5,439,109	Aug. 8,
		(filed Dec. 28, 1993)

The rejection

Claims 1, 3, 6, 7, 10, 11, 13, 15, 16, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over McBride in view of Rosenbloom.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed December 15, 1997) for the examiner's complete

reasoning in support of the rejections, and to the appellants' brief (Paper No. 9, filed September 12, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection in this case is under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references

before him to make the proposed combination or other modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the

appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal. The examiner is of the opinion that McBride discloses the claimed limitations except for the end cover formed integral with the sidewall and a support attached to the sidewall (examiner's answer at page 5). The examiner has cited Rosenbloom for disclosing a bag having a sidewall on which a first circumferential hoop 23 and a second circumferential hoop/support 24 are attached. The second circumferential hoop/support 24 is

made of metal or other stiff flexible material which retains its circular shape when unrestrained (col. 3, lines 17-21).

The examiner concludes that:

It would have been obvious to one having ordinary skill in the art in view of Rosenbloom '468 to modify the device of McBride so it includes a support attached

to the sidewall of the device to retain the interior compartment while the device lies on the sidewall and also to facilitate removing the cord out of the compartment.
[examiner's answer at page 5]

We do not agree. Rosenbloom discloses:

The construction employing hoop members 23 and 24 along with a plurality of vertical stiffening members 25 permits the portion of container body 20 between hoop members 23 and 24 to maintain an upstanding position 26 as shown in FIG. 2 while the nonstiffened portion 26 collapses upon itself when there is nothing to hold it in its upstanding position as shown in FIG. 1. (Col. 3, lines 34 to 40).

The hoop members 23 and 24 of Rosenbloom are utilized to help maintain the container in an upright position, not to retain the interior compartment while the device lies on the sidewall. McBride likewise does not disclose that it is desirable to lie the bag on its sidewall. In addition, it is not necessary to include the hoop members of Rosenbloom to maintain the McBride bag in the upright position as McBride includes a base portion 14 which is sturdy enough to support the device (Col. 4, lines 1 to 3; Figure 1).

Moreover, Rosenbloom discloses that the hoop members 23 and 24 are utilized along with stiffening members 25 (col. 3, lines 13-17). As such, Rosenbloom would have suggested to a

person of ordinary skill in the art to use the hoop members along with the stiffening members 25. However, McBride teaches that in operation, the portion of the bag just below the aperture is grasped to thereby create a bottleneck so as to clean the cord as it is placed in the bag (Col. 4, lines 21 to 31). Therefore, were the hoop members utilized with the stiffening member 25 as suggested by Rosenbloom, the stiffening members taught by Rosenbloom would interfere with the cleaning action of the McBride bag.

In view of the above, we are in agreement with the appellants that there is no suggestion in the prior art to combine the teachings of McBride and Rosenbloom. The decision of the examiner is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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